

REMARKS/ARGUMENTS

I. THE ELECTION/RESTRICTION REQUIREMENT

The June 8, 2009 Office Action requires an election of an invention under 35 U.S.C.

§§ 121 and 372 from the following groups of inventions:

- Group I** Claims 1-4, drawn to a slab;
- Group II** Claims 5-7, drawn to a mold and process of manufacturing; and
- Group III** Claims 8-11, drawn to a process of laying.

The Office Action asserts that the above indicated groups of inventions are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In response to the request for restriction, Applicant elects for further prosecution in this application, the invention associated with Group I, claims 1-4, drawn to a slab. This election is made *with traverse* and is made without prejudice to the Applicants' right to file divisional applications directed to the non-elected subject matter. It is respectfully requested that the restriction requirement be favorably reconsidered and withdrawn.

Initially, Applicant notes that two Office Actions on the merits have issued in this application with no indication that a restriction was in order. In the responses to the previous Office Actions, only clarifying amendments were made. Accordingly, nothing in the prosecution has made the restriction necessary or proper at this point in prosecution. The M.P.E.P. indicates that the Examiner should make a proper restriction requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops. *M.P.E.P.* § 811. Because nothing in the prosecution resulted in the need for a proper

requirement to develop, Applicant respectfully submits that the present restriction requirement is not proper.

The M.P.E.P. lists two criteria for a proper restriction requirement. First, the invention must be independent or distinct. *M.P.E.P.* § 803. Second, searching the additional invention must constitute an undue burden on the examiner if restriction is not required. *Id.* The M.P.E.P. directs the Examiner to search and examine an entire application “[i]f the search and examination of an entire application can be made without serious burden, . . . even though it includes claims to distinct or independent inventions.” *Id.* As particularly applicable to the instant application, the M.P.E.P. recites, “Before making a restriction requirement after the first action on the merits, the Examiner will consider whether there will be a serious burden if restriction is not required.” *M.P.E.P.* § 811. (Emphasis added.)

Furthermore, every restriction requirement has two aspects: (a) the reasons why each invention as claimed is either independent or distinct from the others; and (b) the reasons why there would be a serious burden on the Examiner if restriction is not required, i.e., the reasons for insisting upon restriction. *M.P.E.P.* § 808. Even if the Examiner shows that the related inventions are independent and distinct (Applicant’s attorneys respectfully disagree with the Examiner that the inventions are separate and distinct), “the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required.” *Id.* at § 808.02. In order to establish a serious burden, the Examiner must show by appropriate explanation one of the following: (a) separate classification thereof; (b) a separate status in the art when they are classifiable together; or (c) a different field of search. *Id.* Applicant respectfully submits the Examiner has not established

why a serious burden would exist if the restriction was not required. Applicant therefore submits the restriction requirement is improper and requests reconsideration and withdrawal thereof.

Applicant further notes the Written Opinion of the PCT application, issued by the European Patent Office as the international search authority, and submitted with the initial application, found unity of invention was not lacking in the originally filed application. Because no substantive amendments have been made to the claims, unity of invention has not been altered during the prosecution. Applicant respectfully submits the Written Opinion is further proof that the restriction requirement is improper.

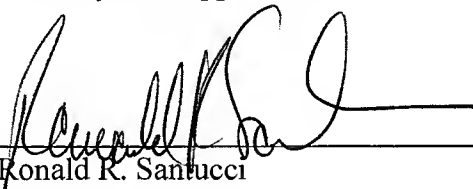
CONCLUSION

An early examination on the merits of the claims of this application is respectfully solicited.

Please charge any fees incurred by reason of this response and not paid herewith to Deposit Account No. 50-0320.

Respectfully submitted,
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